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Mari Saito

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EXAMINER

ABEL JALIL, NEVEEN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARI SAITO, NORIYUKI YAMAMOTO,
HIROYUKI HOURIN, and KAZUNORI OHMURA

Appeal 2008-1232
Application 09/785,204
Technology Center 2100

Decided: April 10, 2008¹

Before JOSEPH L. DIXON, LANCE LEONARD BARRY,
CAROLYN D. THOMAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER

I. STATEMENT OF THE CASE

¹ An oral hearing was scheduled for April 8, 2008. Neither the Appellants nor a representative thereof appeared at the hearing. Therefore, we review this appeal solely upon the Briefs.

A Patent Examiner rejected claims 1-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

II. LEGAL PRINCIPLES

When the Appellants filed their Second Supplemental Appeal Brief, such a brief was required to include "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters." 37 C.F.R. § 41.37(c)(1)(v) (2005).¹² Furthermore,

[f]or each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of [37 CFR 41.37](c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Id. Reference to page and line number of the specification and to the reference characters of the drawings "is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." MPEP § 1205.02 (8th ed., Rev. 6, Sep. 2007).

III. ANALYSIS

² We cite to the version of the Code of Federal Regulations in effect when the Appellants filed their Second Supplemental Appeal Brief. The current version includes the same rules.

Here, claims 1, 7, 8, 9, 15, and 16 are the independent claims involved in the instant appeal. Claim 1 recites in pertinent part the following elements: "associated information," "existing information corresponding to a past event," and "existing information having similarity to information." The Appellants' *Summary of the Claimed Subject Matter* ("*Summary*") (2d Supp. App. Br. 2-7), however, fails to map any of these elements to the reference characters of the Appellants' forty-two figures.

Claims 7 and 8 each comprise eight steps. Regarding these claims, the *Summary* refers to "the flow charts of Figure 3 and Figure 5" (*id.* 4); these Figures collectively comprise sixteen steps. The *Summary*, however, fails to map the individual steps of the claims to the individual steps of Figures 3, 5, or of any other figures. From our review of the identified Figures, we do not find a one-to-one correspondence of the claimed method steps to the generalized steps in the Figures. Therefore, we find the *Summary* to be less than concise because it does not address the merits of the claimed invention.

Claim 9 recites "[a]n information processing apparatus" that includes a "command processing means" and a "display control means." Regarding the means plus function elements, the *Summary* refers "to step S18 of FIG. 5 or step S42 of the FIG. 7" (*id.* 5), to steps S31 and S41 of the latter Figure, and to discussions thereof. (*Id.*) Figures 5 and 7 depict methods steps, however, rather than the structure of an apparatus.

Claims 15 and 16 each recites in pertinent part an "initial 'detecting' step[]," (*id.*), a "keyword detecting step[]" (*id.*), a "searching step[]" (*id.*), and an "inputting" step. (*Id.*) Regarding the initial detecting step, the *Summary* refers to "lines 22-24 of page 14 and lines 1-2 of page 15 of the specification" (*Id.*) These lines describe a functional "event extraction block" (Spec. 14), which is a component of an apparatus, however, rather than a step of a method. Regarding the keyword detecting step, the *Summary* refers to a "data base inquiry block 9" (2d Supp. App. Br. 5) and to a discussion thereof. (*Id.*) This block is a component of an apparatus, however, rather than a step of a method. Regarding the searching step, the *Summary* refers to an "information retrieval block 6" (*id.* 6), to the "database inquiry block 9," (*id.*), and to a discussion thereof. (*Id.*) These blocks are components of an apparatus, however, rather than steps of a method. Furthermore, although Figures 3, 5, and 7, *inter alia*, depict flow charts comprising steps, the *Summary* fails to map the individual initial detecting step, keyword detecting step, searching step, or inputting step of claims 15 and 16 to any of the individual steps of the Figures.

IV. ORDER

We decline to substitute our speculation for the greater certainty that should come from the Appellants.³ More specifically, the Appellants must submit a substitute *Summary of Claimed Subject Matter*. The substitute *Summary* shall include the following features:

³ We had planned to ask the Appellants or their representative for clarification at the oral hearing thereby avoiding the need for this order.

- a mapping of the "associated information," "existing information corresponding to a past event," and "existing information having similarity to information" of claim 1 to the corresponding reference characters of the Appellants' figures,
- a mapping of each of the steps of claims 7 and 8 to the corresponding, individual steps of Figures 3, 5, or 7,
- a mapping of each means-plus-function limitation in claim 9, including the "command processing means" and the "display control means," to specific pages and line numbers of the Appellants' Specification and to specific reference characters of their figures **where the corresponding structure is described and shown**, respectively; and
- a mapping of each of the steps of claims 15 and 16, including the initial detecting step, keyword detecting step, searching step, and inputting step, to the corresponding, individual steps of Figures 3, 5, or 7.

Under 37 C.F.R. § 41.50(d), we give the Appellants a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of this appeal. 37 C.F.R. § 41.50(d).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

clj

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Application 09/785,204

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